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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,205	10/09/2003	Syozo Kobayashi	243895US0DIV	5872
22850	7590	10/01/2004		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER HABTE, KAHSAI	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/681,205

**Applicant(s)**

KOBAYASHI ET AL.

**Examiner**

Kahsay Habte, Ph. D.

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-17 and 23-26 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17 (in part) and 23-26 (in part), drawn to  $Q^3$  = 7-9 membered ring with 2 nitrogens, classified in class 540, subclass various.
- II. Claims 1-8 (in part), 11-17 (in part) and 23-26 (in part), drawn to  $Q^3$  = 5-membered ring with one nitrogen, classified in class 548, subclass various.
- III. Claims 1-8 (in part), 11-17 (in part) and 23-26 (in part), drawn to  $Q^3$  = 6-membered rings with one nitrogen, classified in class 546, subclass various.
- IV. Claims 1-8 (in part), 11-17 (in part) and 23-26 (in part), drawn to  $Q^3$  = 7-membered rings with one nitrogen, classified in class 540, subclass various.
- V. Claims 1-17 (in part) and 23-26 (in part), drawn to  $Q^3$  = others, classified in class 544, subclass various.

The inventions are distinct, each from the other because of the following reasons:

Groups I-V are directed to structurally dissimilar compounds such that the variable core created by the varying definitions of  $Q^3$  in formula I do not belong to the same recognized class of chemical compounds in the art, and references anticipating one invention, would not render obvious the others. For example, Group I is drawn to a 7-9

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membered ring with 2 nitrogens and is different from Group II-V. Group II is drawn to monoazoles and is different from Group I or Groups III-V, since this is not present in other groups. Group III is different from other groups, since it is drawn to monoazines (6-membered ring with one nitrogen). Group IV is drawn to a 7-membered ring with one nitrogen and is different from Groups I-III and Group V. Group V is drawn to others (Groups that don't fall into Groups I-IV, e.g. 6-membered ring with 2 nitrogens) and it is different from other groups. Thus, separate searches in the literature as well as in the U.S. Patent Classification System would be required. Each group's compounds are made and used independently of each other and could support separate patents. The compounds differ significantly in chemical structures. One skilled in the art would not consider such diverse structure equivalents of each other.

Because these inventions are distinct for the reasons given above and have acquired separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

In addition, applicants have to elect a single disclosed species.

A telephone call was made to Mr. Roland Martin on Sept. 10, 2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

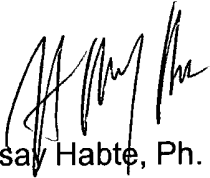
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**Conclusion**

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on (571) 272-0674, if there is no reply within 24 hours, James Wilson (Acting SPE) can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kahsay Habte, Ph. D.  
Examiner  
Art Unit 1624



Mukund J. Shah  
Supervisory Patent Examiner  
Art Unit 1624

KH  
September 28, 2004